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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,883	03/13/2001	Junichi Umehara	9366/8001	1834

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EXAMINER
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GARG, YOGESH C

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/804,883

Applicant(s)

UMEHARA, JUNICHI

Examiner

Yogesh C Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 and 35 is/are pending in the application.
- 4a) Of the above claim(s) 11-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/24/01&amp;12/31/02</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's election without traverse of claims 1-10 and 35 in the reply filed on August 2, 2004 is acknowledged. The examiner acknowledges that claims 11-24 are withdrawn and claims 36-41 are cancelled. Currently claims 1-10 and 35 are pending for examination.
2. Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Polash (WO 99/18518 published on April 15, 1999).

**Regarding claims 1-3,** Polash teaches a method for online purchasing of electronic information (see at least abstract, "*The web server can further comprise an interface or connection to a database that indexes music selections to a table of recordings, such as an album, CD or Video, and that further indexes the recording to an audio sample that can be downloaded over the Internet or other computer network to allow a consumer to listen and determine if the downloaded sample relates to the preferred selection of the consumer. Optionally, the web server can include a transaction server for allowing the consumer to purchase the selection or associated CD.*" ) comprising the steps of:

a) selecting said electronic information, b) paying for said electronic information, c) directly receiving said electronic information by a user printing device and d) printing said electronic information on a medium, d) sampling said electronic information and e) selectively mixing and ordering a plurality of selected electronic information (see at least page 6, line 27-page 8, line 2, "*.....As depicted in Figure 2, the page includes a play list 42.....The information can be present for past, present and future and playback can be available of CD samples played in the past and future.....A user can activate the playback button to request a sample of a selected song to be downloaded to the terminal 14.....The page 40 can also include the order control 46 that allows the user to order a selection, ....The transaction server can operate to provide the necessary forms to the consumer and to implement the commercial transaction that allows the consumer to purchase the selection over the network 10.....Optionally, users may buy individual selections via download.....*". Note: The computer terminal 14 corresponds to the user's

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printing device including a medium on which the songs can be downloaded that is printed and the completion of purchase transaction inherently implies making payment for the purchased selection.).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-10 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Polash and further in view of Salisbury et al. (US Patent 6,041,703); hereinafter, referred to as Salisbury.

**Regarding claims 4-10**, Polash teaches a method for online purchasing of electronic information by selectively mixing and ordering a plurality of selected electronic information in the form of songs as analyzed for claims 1-3 above. Polash does not disclose the limitations of claims 4-10. However, in the same filed of printing/recording data on CDs and labeling them, Salisbury suggests all the limitations of claims 3-10, that is : selectively labeling said electronic information, printing a user-selected label on said medium, wherein said label includes a photo/title/video scene/concert information (see at least col.1, lines 31-35, " *The present invention speeds up and improves the steps involved in the manufacturing*

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*process for recording and preparing a CD by significantly reducing the number of manual handling steps required to record, verify and print label information on a CD. ...*

***Commercially available compact discs can include some generic pre-printed information on a top surface of the disc. For example, a manufacture of the disc may include an identification mark, logo, or trademark.. " , col.6, lines 1-15, " Referring to FIG. 4, a top surface of a compact disc 90 is illustrated..... As indicated above, preprinted generic information may be located on commercially available compact discs. This information may be in the form of an image comprising graphics, text, manufacturers identification, logo, trademark, background field, or other types of indicia such as a bar code. For purposes of conciseness, the term "image" is used herein to describe any material provided or printed on a surface of a compact disc and is not limited to textual information, identification, or identifying marks. ". ).***

In view of Salisbury, it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Polash to incorporate the features of selectively labeling said electronic information, printing a user-selected label on said medium, wherein said label includes a photo/title/video scene/concert information. Doing so enables the users to include additional individualized information on the top surface of the compact disc to identify the data recorded/printed on the CD and/or identify the user who prepared that CD or the user who is going to use it himself, as explicitly suggested in Salisbury (see at least col.1, lines 36-52).

**Regarding claim 35**, all the limitations are already covered in claims 1-10 and therefore it is analyzed and rejected as being unpatentable over Polash and further in view of Salisbury on the same basis.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) US Patent 6,243,725 to Hempleman et al. (see at least col.1, line 1-col.8, line 45) discloses a method for online purchasing electronic information, such as songs, selecting, sampling them and purchasing from a list of items and subsequently directly downloading/printing on a medium. Hempleman's reference renders the recited limitations in claims 1-10 and 35 obvious in view of Salsbury reference.

(ii) US Patent 5,611,066 Keele discloses a system, an apparatus and a method to print/download electronic information on a medium, such as CD and label it with desired information (see at least abstract).

(iii) US Patent 5, 918,213 to Bernard et al. (see at least col.13, lines 3-64) teaches a method for online purchasing electronic information, such as songs, selecting, sampling them and purchasing from a list of items.

(iv) US Patents 6,020,977 to Kim (see col.1, line 1-col.4, line 42), 6,270,176 to Kahle (see at least col.1, line 1-col.4, line 31) and PG-PUB 20040021907 to Truc et al. disclose labeling information on CDs.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F(8:30-4:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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Yogesh C Garg  
Primary Examiner  
Art Unit 3625

YCG  
September 27, 2004